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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,806	06/18/2001	Craig Stuart Skinner	PALM-3611.US.P	4757

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EXAMINER

DENNISON, JERRY B

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,806

Applicant(s)

SKINNER ET AL.

Examiner

J. Bret Dennison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Action is in response to Amendment for Application Number 09/884,806 received on 30 December 2005.
2. Claims 1-31 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

MPEP 2164.06(a) acknowledges that it is common that doubt arises about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art could not develop without undue experimentation. In such a case, the examiner should specifically identify what information is missing and why the missing information is needed to provide enablement.

Examiner could only find the following reference to any sort of "discovering":

"These operational parameters define an operational state of the handheld device and is typically discovered through extensive calibration procedures conducted within controlled environments" [see Specification, page 23, lines 15-20].

This reference does not provide sufficient evidence to teach one skilled in the art to make and/or use the invention without undue experimentation. Discovering through extensive calibration procedures conducted within controlled environments does not seem to include the same purpose as discovering information within an electronic device such as a PDA.

The Federal Circuit has repeatedly held that "the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation'." In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

Examiner respectfully requests Applicant to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites in limitation a), "discovering and extracting from said electronic device", and in limitation b), "storing said personality file on said electronic device". It is vague and unclear to Examiner how information is extracted "from" the device and stored "on" it.
5. Claim 22 includes the same issue. It is vague and unclear to Examiner how information is extracted "from" the device and stored "on" it.
6. Claim 11 recites the limitation, "said electronic device", multiple times in the claim. There is insufficient antecedent basis for this limitation in the claim. Examiner will interpret "said electronic device" to read "said PDA" based on the changes in the claim and Applicant's arguments.
7. Claim 11 recites the limitation, "importing data contained within said selected file that is stored in said PDA into said [PDA]." It is vague and unclear to Examiner what this limitation means, with respect to importing data in a PDA in which the data was already in the PDA.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 11, 22, 23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodard et al. (U.S. Patent Application Publication 2002/0104080) in view of Kliland (U.S. Patent Application Publication 2002/0065905).

8. Regarding claims 1, 11, and 22, Woodard disclosed in an electronic device, a method of restoration comprising the steps of:

automatically extracting for restoring purposes from said electronic device, information unique to said electronic device, wherein said information comprises critical operating parameters;

automatically creating a personality file;

automatically writing said information into said personality file; and
automatically storing said personality file on said electronic device (Woodard, Abstract, page 2, p 9-11, page 3, p 46, 47, page 4, p 51, Woodard disclosed extracting information into a directive file, the information including operating system files, and unique information for purposes of restoring a crashed system, as well as restoring the files).

However, Woodard does not explicitly state wherein the data contained within said selected file is for restoring radio calibration parameters for adjusting the frequency of wireless communication by said electronic device.

In an analogous art, Kliland disclosed an arrangement for equipment remote control according to a user profile wherein data including restoring user profile information to obtain the required equipment functions, capabilities and properties

according to Bluetooth wireless technology devices (Kliland, page 3, paragraphs 40-44, 48).

Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate the teachings of Kliland into Woodard benefiting the user of the wireless device in not having to repeatedly manually configure the device after a system crash (Kliland, page 1 paragraph 4, Woodard, see Abstract).

9. Regarding claims 2 and 23, Woodard disclosed the limitations, substantially as claimed, as described in claims 1 and 22, including transferring the data to a second device (Woodard, page 4, p 51).

10. Regarding claims 4 and 25, Woodard and Kliland disclosed the limitations, substantially as claimed, as described in claims 1 and 22, including storing said personality file in random access memory (Woodard, page 14, p 287).

11. Regarding claim 5 and 26, Woodard and Kliland disclosed the limitations, substantially as claimed, as described in claims 1 and 22, including

automatically locating a plurality files, including said personality file, stored within said electronic device containing said information, each of said plurality files following a format unique said method; automatically displaying a list of said plurality of files;

automatically acknowledging selection of one of said plurality of files, a selected file;
and automatically importing data contained within said selected file into said selected device (Woodard, page 4, p51-53, Woodard disclosed).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woodard and Kliland in view of Blonder (U.S. Patent Number 5,802,275).

12. Regarding claim 3, Woodard disclosed the limitations, substantially as claimed, as described in claims 1 and 22, including automatically extracting state information unique to said electronic device (Woodard, page 4, p 51-54, Woodard taught a Load Review stage that gathers information about the user's computer-based device).

However, Woodard does not explicitly state wherein said state information configures said electronic device for wireless communication.

In an analogous art, Blonder disclosed a system for backing up data files for a personal digital assistant at a server, for the purpose of restoring in case of loss or replacement (Blonder, col. 6, lines 20-30).

Woodard suggests restoring wireless settings for wireless devices because the environment of Woodard can be considered a wireless network (Woodard, page 2, p 35). Blonder provides a system that allows for backup of software and data on a personal digital assistant (Blonder, col. 6, lines 20-35). Therefore it would have been obvious for one in the ordinary skill in the art at the time of the invention to incorporate the restoration of wireless settings as shown in Blonder into the teaching of Woodard to

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provide a system to users to be able to backup application settings, software, and data (Woodard, see Abstract) for wireless devices in an easily distributed and downloaded manner, preventing users from losing important data and settings for their devices (Bolder, col. 6, lines 10-25)

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder (U.S. Patent Number 5,802,275) in view of Kliland (U.S. Patent Application Publication 2002/0065905).

13. Regarding claims 1 and 22, Blonder discloses in an electronic device, a method of restoration comprising the steps of:

- automatically extracting information unique to said electronic device;

- automatically creating a personality file;

- automatically writing said information into said personality file; and

- automatically storing said personality file on said electronic device (Blonder, col.

3, line 60 through col. 4, line 15, col. 6, lines 13-30, Blonder teaches the user being able to choose data for their PDA, and the server encrypts the data to a file using the ID of the user's PDA, and the user has the option of also backing up their current data by transferring it to the server. It is inherent that the user being able to backup their files on the server includes creating the file to backup, and that backup file is unique to said device by their encryption id).

However, Blonder did not explicitly state wherein the data contained within said selected file is for restoring radio calibration parameters for adjusting the frequency of wireless communication by said electronic device.

In an analogous art, Kliland disclosed an arrangement for equipment remote control according to a user profile wherein data including restoring user profile information to obtain the required equipment functions, capabilities and properties according to Bluetooth wireless technology devices (Kliland, page 3, paragraphs 40-44, 48).

Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate the teachings of Kliland into Blonder benefiting the user of the wireless device in not having to repeatedly manually configure the device after a system crash (Kliland, page 1 paragraph 4, Woodard, see Abstract).

14. Regarding claims 2 and 23, Blonder discloses the limitations, substantially as claimed, as described in claims 1 and 22, including transferring the data to a second device (Blonder, col. 6, lines 13-30).

15. Regarding claims 4 and 25, Blonder and Kliland disclosed the limitations, substantially as claimed, as described in claims 1 and 22, including storing said personality file in random access memory (Blonder, col. 6, lines 15-30, Blonder teaches the user transferring files to the server, which means the file is stored in RAM).

16. Regarding claims 5, 11, 12, and 26, Blonder and Kliland disclosed the limitations, substantially as claimed, as described in claims 1 and 22, including

automatically locating a plurality files, including said personality file, stored within said electronic device containing said information, each of said plurality files following a format unique said method; automatically displaying a list of said plurality files; automatically acknowledging selection of one of said plurality of files, a selected file; and automatically importing data contained within said selected file into said selected device (Blonder, col. 3, lines 60-67, col. 6, lines 15-35, Blonder teaches the user requesting software from a plurality of software for the user's unique PDA to import to their PDA).

17. Regarding claims 9, 21 and 30, Blonder and Kliland disclosed the limitations, substantially as claimed, as described in claims 1, 11, and 22, including wherein said electronic device is a personal digital assistant with wireless capabilities (Blonder, col. 1, lines 35-40).

18. Regarding claims 10 and 31, Blonder and Kliland disclosed the limitations, substantially as claimed, as described in claims 1 and 22, including wherein said personality file is a memo file associated with a memo application in an operating system of said electronic device (Blonder, col. 6, lines 24-26, Blonder teaches that users can back up data files related to applications).

19. Regarding claim 15, Blonder and Kliland disclosed the limitations, substantially as claimed, as described in claim 11, including acknowledging selection of said selected file by a user (Blonder, col. 6, lines 20-30, Blonder teaches users being able to make a selection of data to restore and the server transferring it, inherently acknowledging the user's selection).

20. Regarding claims 16, 17, and 18, Blonder and Kliland disclosed the limitations, substantially as claimed, as described in claim 11, including automatically extracting data unique to said electronic device, creating a personality file, writing data to said personality file, and storing said personality file on said electronic device, said personality file also said selected file (Blonder, col. 3, lines 60-65, col. 4, lines 5-15, col. 4, lines 40-50, Blonder teaches encrypted data stored on the server by the unique id of the device, col. 6, lines 15-30, Blonder teaches users being able to transfer data to the server using this unique ID as the identification of the device's data, inherently meaning that the user must create and store the file of device data before transferring, and also inherently meaning that the devices must be synchronized for proper data transfer).

21. Regarding claim 19, Blonder and Kliland disclosed the limitations, substantially as claimed, as described in claim 17, including locating personality file on said second electronic device and storing a copy of said personality file on said electronic device (Blonder, col. 6, lines 15-30).

22. Regarding claims 3, 13, and 24, Blonder and Kliland disclosed the limitations, substantially as claimed, as described in claims 1 and 22. Blonder also teaches that the reason for backing up software is for getting rid of viruses (Blonder, col. 2, lines 10-25). Blonder does not explicitly state extracting state information unique to said electronic device, said state information configuring said electronic device for communication. However, it would have been obvious to one in the ordinary skill in the art at the time of the invention that backing up software in case of a virus would also include backing up configuration settings for wireless communications within a PDA to provide the user with a fresh copy of software that is clean from any virus (Blonder, col. 1, lines 10-40).

23. Regarding claims 6, 7, 14, and 27, and 28, Blonder and Kliland disclosed the limitations, substantially as claimed, as described in claims 5, 12, and 26. Blonder also teaches that the reason for backing up software is for getting rid of viruses (Blonder, col. 2, lines 10-25). Blonder does not explicitly state wherein the data comprises a plurality of pre-determined operational parameters, each of which are stored in a corresponding pre-determined location within flash memory of said electronic device and wherein said step h) further comprises the step automatically importing each of said plurality of pre-determined operational parameters to said corresponding pre-determined locations. However, it would have been obvious to one in the ordinary skill in the art at the time of the invention that backing up software in case of a virus would also include importing predetermined operational parameters to said corresponding predetermined locations

within flash ROM in order for the electronic device to function properly as it did without the virus.

24. Regarding claims 8, 20, and 29, Blonder and Kliland disclosed the limitations, substantially as claimed, as described in claims 1, 11, and 22, including wherein files are in a format including a serial number of said electronic device (Blonder, col. 3, line 55 through col. 4, line 15, Blonder teaches files being encrypted with device ID).

Blonder does not explicitly state wherein said format includes time/date stamp or following that format. However, it would have been obvious to one in the ordinary skill in the art at the time of the invention to include time/date stamp for each created file to enable users to keep track of backed up files on the server.

Response to Amendment

Applicant's arguments and amendments filed on 30 December 2005 have been carefully considered but they are not deemed fully persuasive.

Applicant's arguments with respect to claims **1** and **22** have been fully considered but they are not persuasive.

Regarding Applicant's arguments that the cited prior art does not teach, "for restoring purposes", or "for restoring radio calibration parameters for adjusting the frequency of wireless communication by said PDA" [see Applicant's Response, page 22, second paragraph], these limitations are statements of intended use. Any language that suggests or makes optional but does not require steps to be performed or does not

limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEP 2106, section II, subsection C for specific examples.

Applicant's arguments with respect to claims 1 and 22 include the failure of previously applied art to expressly disclose the teachings of a "the present method for automated personality transfer in which critical operating parameters are discovered and extracted for restoring purposes" [see Applicant's Response, page 13, last paragraph, page 19, second paragraph].

Examiner respectfully disagrees.

Examiner would like to point out that the claims do not contain any "automatic" features, due to Applicant's amendments. Examiner also does not see any type of "personality transfer" in these claims. Claims 1 and 22 simply disclose backing up information unique to said client. There is no transfer of data at any kind.

Applicant's arguments with respect to claim 11 include the failure of previously applied art to expressly disclose the teachings of "importing of data, that is stored on a PDA, back into the PDA for adjusting the frequency of wireless communication by the PDA" [see Applicant's Response, page 17, first paragraph].

As shown in the above rejection, it is vague and unclear to Examiner what this limitation means, with respect to importing data in a PDA in which the data was already in the PDA.

It is evident from the mappings found in the above rejection that Blonder disclosed the teaching of backing up all files for restoration purposes. It is also evident

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that the combination of Blonder and Kliland disclosed backing up wireless settings (Kliland, page 3, paragraphs 40-44, 48).

As it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Blonder and Kliland as well as other prior arts of records disclosed backing up critical operation files including calibration settings for wireless devices is taught as well as other claimed features of Applicant's invention. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

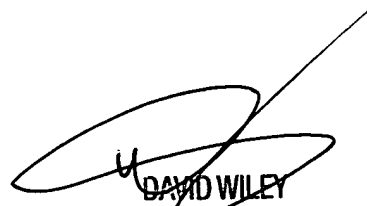
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